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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,832	11/09/2001	Patrice Vincent	Q65738	8154

7590 10/15/2004
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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3732

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	09/890,832		VINCENT, PATRICE	
	Examiner		Art Unit	
	Anu Ramana		3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

New grounds of rejection have been made in this office action in view of the newly discovered copending application 10/471,888. Applicant is reminded of 37 CFR 1.56 and his duty to bring to the attention of the examiner information as to other copending applications which are "material to patentability" of the instant application (MPEP 2001.05 and 2001.06(b)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 8, it is unclear what structure the Applicant is referring to by the limitation "the entire section of the body" since the body has several portions or sections. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

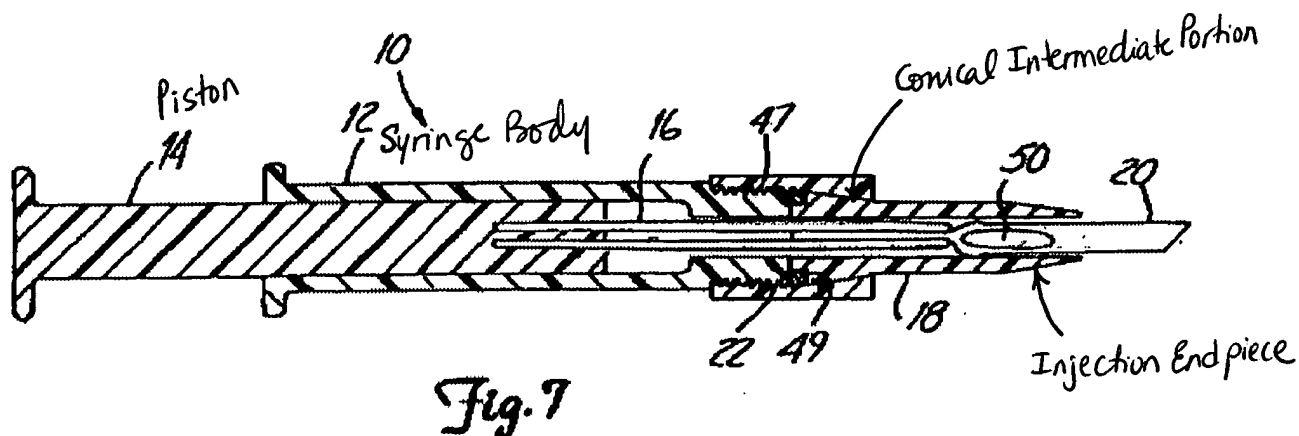
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 9 and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Blake (US 6,280,449).

Blake discloses a device for injecting a lens including a single piece or "individual" syringe body assembled from a cylindrical portion 12, a conical intermediate portion and an injection endpiece including a piston 14 wherein an injection end of the piston has a plurality of

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plastic blades or "fingers" or "elongate members" 16 that flex toward each other and "occupy practically the entire section of the body" (Figure 7, col. 11, lines 48-67 and col. 12, lines 1-67 and col. 13, lines 1-14). See marked up Figure 7 from Blake below.



Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6 and 9-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2, 6, 7 and 15 of copending Application No. 10/471,888. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the present application and the claims of the copending application is that the claims of the copending

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application include many more elements and are thus more specific. Thus the invention of the claims of copending application is in effect a “species” of the “generic” invention of the claims of the present application. It has been held that the generic invention is “anticipated” by the “species.” See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the claims of the copending application, they are not patentably distinct from the claims of the copending application.

Regarding claim 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the fingers of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 10/471,888 (‘888 herein) in view of Blake (US 6,280,449).

Claim 5 of ‘888 discloses all elements of the claimed invention except for a wedge-shaped central finger.

Blake teaches blades or fingers with different shapes to advance an implant through a syringe body (col. 12, lines 62-67 and col. 13, lines 1-27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an appropriately shaped (for e.g., wedge shaped) central finger, as taught by Blake, for the purpose of advancing an implant through a syringe body.

This is a provisional obviousness-type double patenting rejection.

Claims 7 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/471,888 (‘888 herein) in view of Figueroa et al. (US 5,873,879) and Lane (US 5,964,736).

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Claim 2 of '888 discloses all elements of the claimed invention except for a sealing gasket and a stopper.

Figueora et al. teach a syringe body in which a lens 12 can be preloaded and shipped to a user in a suspended state (Fig. 13, col. 3, lines 17-28 and col. 4, lines 7-34).

Lane teaches a prefilled cartridge or "syringe" 48 wherein a twist off cap seal 52 is provided at one end and a plunger retention ring or sealing gasket 54 is provided at another end to prevent any internal pressure within the syringe 48 from forcing the plunger out of the syringe (Figs. 3, 4 and 8, col. 7, lines 9-27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a twist off cap seal 52 at one end and a sealing gasket 54 on the plunger of the device of the combination of Figueora et al. and claim 2 ('888), as taught by Lane, to prevent the plunger from moving out of the syringe.

Regarding claim 8, Figueroa et al. teach that the device can be made of metal or a plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the device of the combination of claim 2 ('888), Figueroa et al. and Lane of metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

The indicated allowability of claims 5, 6 and 10 is withdrawn in view of the newly discovered copending application 10/471,888.

Response to Arguments

Applicant's arguments under "REMARKS" in the response filed on July 13, 2004 have been carefully considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*
October 12, 2004

Kevin Shaver
KEVIN SHAVER
SUPERVISORY PATENT EXAMINER
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